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1                   UNITED STATES PATENT AND TRADEMARK OFFICE

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4                   BEFORE THE BOARD OF PATENT APPEALS  
5                   AND INTERFERENCES

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8                   *Ex parte* BRENDA POMERANCE

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11                   Appeal 2008-0100  
12                   Application 09/543,049  
13                   Technology Center 3600

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16                   Decided: November 21, 2008

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19                   *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID  
20                   B. WALKER, *Administrative Patent Judges.*

21

22                   CRAWFORD, *Administrative Patent Judge.*

23

24                   DECISION ON APPEAL

25

26                   STATEMENT OF THE CASE

1           Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection  
2 of claims 46-63 and 85-89<sup>1</sup>. We have jurisdiction under 35 U.S.C. § 6(b)  
3 (2002). We affirm-in-part.

4           Appellant invented a method for processing a complaint in an  
5 automated alternative dispute resolution process (Specification 2:14-17).

6           Claim 46, reproduced below, is further illustrative of the claimed  
7 subject matter:

8           46. A method of processing a complaint,  
9 comprising:  
10           automatically receiving, at a computer,  
11 initial information from a complainer including  
12 information identifying the complainer,  
13           automatically selecting, at the computer,  
14 selected data from data previously received from a  
15 complainee based on the initial information from  
16 the complainer,  
17           automatically providing, from the computer,  
18 the selected data to the complainer,  
19           automatically receiving, at the computer,  
20 additional information from the complainer after  
21 providing the selected data to the complainer,  
22           automatically preparing, at the computer, the  
23 complaint based on the initial information and the  
24 additional information received from the  
25 complainer,  
26           automatically presenting, from the  
27 computer, the prepared complaint to the  
28 complainer for approval to generate an approved  
29 complaint, and

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<sup>1</sup> Claims 82-84 have been allowed and claims 1-45 and 64-81 have been cancelled.

1                   automatically forwarding, from the  
2                   computer, the approved complaint, including the  
3                   information identifying the complainer, to the  
4                   complainee.  
5

6                 The prior art relied upon by the Examiner in rejecting the claims on  
7                 appeal is:

8                 Sloo                   US 5,895,450           Apr. 20, 1999  
9                 McFarland           US 6,154,753           Nov. 28, 2000  
10                Thiessen           US 5,495,412           Feb. 27, 1996

11  
12                 *Online Mediation Offered for Resolving E-Commerce Disputes*, Press  
13                 Release, Online Resolution (23 March 2000) (hereinafter referred to as  
14                 “Online Resolution”).

15  
16                 Eisen, Joel, *Are We Ready for Mediation in Cyberspace*, 199 Brigham  
17                 Young Univ. Law Review 1305-58 (1998) (hereinafter referred to as  
18                 “Eisen”).

19  
20                 Brownwell, Eileen O., *Say it Right*, IIE Solutions (February 1999)  
21                 (hereinafter referred to as “Brownwell”).

22  
23                 The Examiner rejected claims 46, 48, 50, 52, 53 and 54 under 35  
24                 U.S.C. § 103(a) as being unpatentable over Sloo in view of Online  
25                 Resolution.

26                 The Examiner rejected claims 47, 55-58, and 61-63 under 35 U.S.C.  
27                 § 103(a) as being unpatentable over Sloo in view of Online Resolution, and  
28                 further in view of Eisen.

29                 The Examiner rejected claims 49 and 59 under 35 U.S.C. § 103(a) as  
30                 being unpatentable over Sloo in view of Online Resolution and Eisen, and  
31                 further in view of Brownwell.

1       The Examiner rejected claims 51 and 60 under 35 U.S.C. § 103(a) as  
2 being unpatentable over Sloo in view of Online Resolution and Eisen, and  
3 further in view of McFarland.

4       The Examiner rejected claims 85, 88, and 89 under 35 U.S.C. § 103(a)  
5 as being unpatentable over Sloo in view of Thiessen.

6       The Examiner rejected claim 86 under 35 U.S.C. § 103(a) as being  
7 unpatentable over Sloo in view of Thiessen, and further in view of Eisen.

8       The Examiner rejected claim 87 under 35 U.S.C. § 103(a) as being  
9 unpatentable over Sloo in view of Thiessen, and further in view of  
10 McFarland.

11

## 12                   ISSUES

13       The first issue is whether the Appellant has shown that the Examiner  
14 erred in holding that it would have been obvious to a person of ordinary skill  
15 in the art in view of the combined teachings of Sloo and Online Resolution  
16 to modify the Sloo method so as to include the step of “automatically  
17 forwarding, from the computer, the approved complaint, including the  
18 information identifying the complainer, to the complainee.”

19       The second issue is whether the Appellant has shown that the  
20 Examiner erred in holding that it would have been obvious to a person of  
21 ordinary skill in the art in view of the combined teachings of Sloo, Online  
22 Resolution, and Eisen to modify the Sloo method so as to include the steps  
23 of “automatically forwarding, at the computer, preparing the complaint  
24 including emotional state information based on the information received  
25 from the complainer.”

The third issue is whether the Appellant has shown that the Examiner erred in holding that it would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Sloo and Thiessen to modify the Sloo method so as to include the steps of “automatically receiving, at the computer, a response to the at least one suggested remedy.”

## FINDINGS OF FACT

Appellant invented a method for processing a complaint in an automated alternative dispute resolution process (Specification 2:14-17).

10 Customer 20 sends a complaint to AADR system 60 (Specification  
11 6:5-6).

12 AADR system 60 processes the complaint into a complaint summary  
13 by, among other things, filtering emotional venting from the complaint so as  
14 to ameliorate emotional ranting (Specification 6:6-11 and 17-19; 9:6-10;  
15 Appeal Brief 5).

Indeed, this filtering of emotional reactions is one of the key functions of the invention (Specification 4:6-10).

18 Customer 20 then approves the complaint summary (Specification  
19 10:11-12).

20 Sloo discloses a method, computer program, and apparatus for  
21 handling, processing, and resolving complaints between consumers and  
22 vendors (col. 1, ll. 13-15).

23 The consumer enters a complaint including their phone number,  
24 e-mail address, and personal “complaint resolved” password (col. 4, l. 61  
25 through col. 5, l. 17).

<sup>1</sup> The complaints received by the vendors are anonymous (col. 1, ll. 17-  
<sup>2</sup> 25 and 55-58; col. 6, ll. 42-46).

3 The complaint may include evidence gathered by an evidence  
4 gathering module, for example, audio, video, and satisfaction data (col. 12,  
5 ll. 25-61).

6 Online Resolution discloses that dispute negotiations may be  
7 conducted over e-mail, instant messaging and threaded discussions (Online  
8 Resolution 1).

Online Resolution also teaches that emotions are a big part of the mediation process (Online Resolution 2).

11 Eisen discloses that it is undesirable to filter cathartic feelings and  
12 emotions out of the online mediation process (Eisen 5).

## PRINCIPLES OF LAW

16        “A reference may be said to teach away when a person of ordinary  
17 skill, upon [examining] the reference, would be discouraged from following  
18 the path set out in the reference, or would be led in a direction divergent  
19 from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551,  
20 553 (Fed. Cir. 1994).

22        “[A] combination of familiar elements according to known methods is  
23 likely to be obvious when it does no more than yield predictable results.”  
24 *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a

1           different one. If a person of ordinary skill can  
2           implement a predictable variation, § 103 likely  
3           bars its patentability. For the same reason, if a  
4           technique has been used to improve one device,  
5           and a person of ordinary skill in the art would  
6           recognize that it would improve similar devices in  
7           the same way, using the technique is obvious  
8           unless its actual application is beyond his or her  
9           skill.

10          *Id.* at 1740.

12          The test for obviousness is not whether the features  
13          of a secondary reference may be bodily  
14          incorporated into the structure of the primary  
15          reference; nor is it that the claimed invention must  
16          be expressly suggested in any one or all of the  
17          references. Rather, the test is what the combined  
18          teachings of the references would have suggested  
19          to those of ordinary skill in the art.

20          *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

22          Unless the steps of a method actually recite an  
23          order, the steps are not ordinarily construed to  
24          require one. *See Loral Fairchild Corp. v. Sony*  
25          *Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d, 1865,  
26          1870 (Fed. Cir. 1999) (stating that “not every  
27          process claim is limited to the performance of its  
28          steps in the order written”). However, such a  
29          result can ensue when the method steps implicitly  
30          require that they be performed in the order written.  
31          *See Loral*, 181 F.3d at 1322, 50 USPQ2d at 1870  
32          (stating that “the language of the claim, the  
33          specification and the prosecution history support a  
34          limiting construction[, in which the steps must be  
35          performed in the order written.] in this case”);  
36          *Mantech*, 152 F.3d at 1376, 47 USPQ2d at 1739  
37          (holding that ‘the sequential nature of the claim  
38          steps is apparent from the plain meaning of the

1                   claim language and nothing in the written  
2                   description suggests otherwise').  
3

4     *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342-43  
5     (Fed. Cir. 2001).

6

7                   ANALYSIS

8     *Obviousness Rejection of Claims 46, 48, 50, 52, 54*

9     We are not persuaded that the Examiner erred in holding that it would  
10 have been obvious to a person of ordinary skill in the art in view of the  
11 combined teachings of Sloo and Online Resolution to modify the Sloo  
12 method so as to include the step of "automatically forwarding, from the  
13 computer, the approved complaint, including the information identifying the  
14 complainer, to the complainee."

15     Sloo discloses presenting an anonymous complaint from a consumer  
16 to a vendor by, among other things, removing the phone number and e-mail  
17 address initially provided by the consumer (col. 1, ll. 17-25 and 55-58; col.  
18 4, l. 61 through col. 5, l. 17; col. 6, ll. 42-46; Examiner's Answer 4).

19     Appellant argues that this is evidence of a teaching away (Appeal Brief 9-  
20 10). As to the specific question of "teaching away," our reviewing court in  
21 *In re Gurley*, 27 F.3d at 553 stated:

22                   A reference may be said to teach away when a  
23                   person of ordinary skill, upon [examining] the  
24                   reference, would be discouraged from following  
25                   the path set out in the reference, or would be led in  
26                   a direction divergent from the path that was taken  
27                   by the applicant.  
28

1           Sloo teaches that one may want to file an anonymous complaint if the  
2 consumer does not want to file a face-to-face complaint due to  
3 inconvenience or embarrassment. However, Sloo does not discourage a  
4 complainant that does not find it inconvenient or embarrassing to file a non-  
5 anonymous complaint. As such, Sloo does not teach away from the claimed  
6 invention.

7           In addition, we are not persuaded by Appellant's argument that it was  
8 improper to combine the teachings of Sloo and Online Resolution because  
9 Sloo teaches anonymous complaints and Online Resolution does not. While  
10 it is true that Sloo discloses that anonymous complaints may be *sought*, there  
11 are only two options for a complaint. Either the complaint is non-  
12 anonymous and includes information identifying the complainer, or the  
13 complaint is anonymous and excludes such information. The fact that the  
14 inventor in Sloo *sought* the latter option in no way suggests that the former  
15 option was *unknown* (Examiner's Answer 16-17). Indeed, the fact that the  
16 inventor in Sloo went into lengthy detail about the undesirability of non-  
17 anonymous communications and how to remove personal information from  
18 the complaint to make it anonymous shows that the inventor was aware of  
19 non-anonymous options, how they work, and the results of their use (col. 1,  
20 ll. 17-25 and 55-58; col. 5, l. 61 through col. 6, l. 17; col. 6, ll. 42-46;  
21 Examiner's Answer 4). Accordingly, we agree with the Examiner that the  
22 implementation of a non-anonymous complaint was *known* and the means  
23 for going about the implementation, adding information identifying the  
24 complainer, was *known* and *predictable* (Examiner's Answer 15-16). *See*  
25 *KSR Int'l Co.*, 127 S. Ct. at 1731. This argument is further bolstered by the  
26 Examiner's citation of Online Resolution as disclosing negotiations

1 conducted over e-mail, instant messaging, and threaded discussions, all of  
2 which would include the exchange of identifying information (Online  
3 Resolution 1).

4 We have carefully considered the Declarations of Nora Femenia and  
5 Christina Kallas, but remain unpersuaded that the Examiner improperly  
6 combined Sloo and Online Resolution. The core of the arguments set forth  
7 in the Declarations are (1) mediation and arbitration are different fields  
8 (Declaration of Nora Femenia ¶¶ 8-12; Declaration of Christina Kallas ¶¶ 7-  
9 11) and (2) bodily incorporating Online Resolution into Sloo would not  
10 result in the claimed invention (Declaration of Nora Femenia ¶ 15;  
11 Declaration of Christina Kallas ¶ 14).

12 When a work is available in one field of endeavor,  
13 design incentives and other market forces can  
14 prompt variations of it, either in the same field or a  
15 different one. If a person of ordinary skill can  
16 implement a predictable variation, § 103 likely  
17 bars its patentability. For the same reason, if a  
18 technique has been used to improve one device,  
19 and a person of ordinary skill in the art would  
20 recognize that it would improve similar devices in  
21 the same way, using the technique is obvious  
22 unless its actual application is beyond his or her  
23 skill.

24  
25 *KSR Int'l Co.*, 127 S. Ct. at 1740.

26 We are not persuaded that mediation and arbitration are different  
27 fields in an obviousness context. Both are related to dispute resolution, and  
28 an individual practicing one of arbitration or mediation would be familiar  
29 with methods and techniques in the other. In any case, we are unpersuaded

1 that it would be beyond the skill of a person in mediation or arbitration to  
2 add information identifying the complainer to a complaint. *See id.*

3       Concerning the second point, the test of obviousness is not whether  
4 features of a secondary reference may be bodily incorporated into a primary  
5 reference's structure, nor whether the claimed invention is expressly  
6 suggested in any one or all of references. Rather, the test is what the  
7 combined teachings of references would have suggested to those of ordinary  
8 skill in art. *See In re Keller*, 642 F.2d at 425. Accordingly, the result of  
9 bodily incorporating Online Resolution into Sloo is irrelevant unless  
10 Appellant can show that this bodily incorporation would teach that adding an  
11 e-mail address to a complaint was unknown and the results unpredictable.  
12 Appellant did not make such a showing.

13       We will sustain this rejection.

14

15       *Obviousness Rejection of Claims 47, 55-58, 61-63*

16       We are not persuaded that the Examiner erred by asserting that a  
17 combination of Sloo, Online Resolution, and Eisen renders obvious  
18 "automatically, at the computer, preparing the complaint including  
19 emotional state information based on the information received from the  
20 complainer" as set forth in independent claim 55<sup>2</sup>.

21       The Examiner cites Online Resolution and Eisen as disclosing the  
22 importance of emotions in negotiations (Online Resolution 2; Eisen 5;  
23 Examiner's Answer 17-18). Sloo discloses an evidence recording module

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<sup>2</sup> Page 5 of the Appeal Brief cites the following in the written description as support for this aspect of claim 55: "system 60 summarizes the complaint to filter emotional venting."

1 used by participants in conjunction with the complaint handling apparatus  
2 and method to record evidence needed to back up their complaints (col. 12,  
3 ll. 26-32). Among the evidence that may be collected and appended to the  
4 complaint includes audio, video, and satisfaction data (col. 12, ll. 35-40; 53-  
5 60). At least the satisfaction data, by definition, would include emotional  
6 state information.

7       Given the importance of emotions as disclosed in Online Resolution  
8 and Eisen, and the collection of satisfaction data in Sloo, we agree with the  
9 Examiner that the combined teachings of these references show that it was  
10 known to include emotional state information in the complaint of Sloo.

11       Appellant argues that bodily incorporating Online Resolution and  
12 Eisen into Sloo would not result in the claimed invention (Appeal Brief 10-  
13 ¶¶ 13-14; Declaration of Nora Femenia ¶¶ 13-14; Declaration of Christina Kallas  
14 ¶¶ 12-13). As set forth above, however, the test of obviousness is not bodily  
15 incorporation, but what the combined teachings of references would have  
16 suggested to those of ordinary skill in art. *See In re Keller*, 642 F.2d at 425.  
17 While Eisen in particular may disfavor online dispute resolution, we are  
18 unpersuaded that this, or the results of a bodily incorporation of Eisen into  
19 Sloo, suggests that adding emotional state information is either unknown or  
20 the results unpredictable. *See KSR Int'l Co.*, 127 S. Ct. at 1731.

21       Accordingly, we sustain this rejection.

22

23       *Rejections of Claims 49 and 51*

24       Claims 49 and 51 depend from claim 46. Appellant has not set forth  
25 any additional arguments as to why the Examiner erred in rejecting these

- 1 claims that are different from the argument set forth for claim 46.
- 2 Accordingly, this rejection is also sustained.

3

4 *Rejections of Claims 59 and 60*

- 5 Claims 59 and 60 depend from claim 55. Appellant has not set forth
  - 6 any additional arguments as to why the Examiner erred in rejecting these
  - 7 claims that are different from the argument set forth for claim 55.
- 8 Accordingly, this rejection is also sustained.

9

10 *Obviousness Rejection of Claims 85, 88, and 89*

- 11 We agree with Appellant concerning the narrow point that the
- 12 Examiner improperly combined Sloo and Thiessen in an attempt to render
- 13 obvious “automatically receiving, at the computer, a response to the at least
- 14 one suggested remedy” as set forth in claim 85 (Appeal Brief 16-17).
- 15 Contrary to the assertion on page 22 of the Examiner’s Answer, we agree
- 16 with Appellant that this receiving of a response to the suggested remedy
- 17 occurs *during* complaint preparation because the following recitation in
- 18 claim 85 requires “automatically preparing, at the computer, the complaint
- 19 *based on the information and the response received* from the complainer”
- 20 (emphasis added). While method steps do not usually need to be executed in
- 21 any particular order, the rule does not apply where the claim explicitly or
- 22 implicitly requires a specific order. *See Interactive Gift Express, Inc.*, 256
- 23 F.3d at 1342-43. Because the complaint takes into account the response
- 24 received from the complainer concerning the suggested remedy, the
- 25 response to the suggested remedy in claim 85 must be provided *prior to*
- 26 completion of the complaint generation.

1       The Examiner takes the position that Sloo does not disclose receiving  
2 a response to the suggested remedy, but then cites Thiessen as correcting this  
3 deficiency (Examiner's Answer 12). Even if Thiessen discloses receiving a  
4 response to the suggested remedy, however, the Examiner has not provided  
5 any showing as to how this response is received prior to completion of  
6 complaint generation. Accordingly, the Examiner has not met the initial  
7 burden of establishing a *prima facie* case of obviousness concerning this  
8 aspect, and thus we are constrained to decide in favor of Appellant.

9       The rejection of claims 85, 88, and 89 in view of Sloo and Thiessen is  
10 not sustained. The rejection of claims 86 and 87 are also not sustained for  
11 the same reasons.

12

#### 13                   CONCLUSIONS OF LAW

14       The Appellant has not shown that the Examiner erred in holding that it  
15 would have been obvious to a person of ordinary skill in the art in view of  
16 the combined teachings of Sloo and Online Resolution to modify the Sloo  
17 method so as to include the step of "automatically forwarding, from the  
18 computer, the approved complaint, including the information identifying the  
19 complainer, to the complainee."

20       The Appellant has not shown that the Examiner erred in holding that it  
21 would have been obvious to a person of ordinary skill in the art in view of  
22 the combined teachings of Sloo, Online Resolution, and Eisen to modify the  
23 Sloo method so as to include the steps of "automatically forwarding, at the  
24 computer, preparing the complaint including emotional state information  
25 based on the information received from the complainer."

1 The Appellant has shown that the Examiner erred in holding that it  
2 would have been obvious to a person of ordinary skill in the art in view of  
3 the combined teachings of Sloo and Thiessen to modify the Sloo method so  
4 as to include the steps of “automatically receiving, at the computer, a  
5 response to the at least one suggested remedy.”

6

## DECISION

8 The Examiner's rejection of claims 46-63 is sustained. The  
9 Examiner's rejection of claims 85-89 is not sustained.

10 No time period for taking any subsequent action in connection with this  
11 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

12

AFFIRMED-IN-PART

14

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16

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